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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Craig Paulsen

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03/16/2010

Weaver Austin Villeneuve & Sampson LLP - IGT

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EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

03/16/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@wavsip.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/964,962	<b>Applicant(s)</b> PAULSEN ET AL.	
	<b>Examiner</b> M. Sager	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 27-60 and 63-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-60 and 63-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

***Specification***

1. The amendment filed 11/5/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: replacing 'infinite' with --virtually unlimited-- is new matter for entry in specification for amendment on pages 2-3.

Applicant is required to cancel the new matter that in this case is replacing 'virtually unlimited' with --infinite-- as originally filed in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

2. Claims 27-60 and 63-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment filed 2/3/06 entered new matter regarding 'addressable pixels' that has presently been amended in paper filed 11/5/09 for panel having a plurality of 'portions' (clms 27, 33, 37, 72) where 'portions', as would be interpreted by an artisan, continues to pertain to addressable pixels or to a plurality of such addressable pixels as remarks on page 14 highlight such equivalence between the language: 'Individual portions of the flexible display each provide an area on which graphical designs may be "lit up" for example, by an array of LCDs or LEDs'. Thus an artisan would interpret there being no discernible difference between 'addressable pixels' and 'portions' as amended and thus 'portions' as referring to addressable pixels continues to be new matter.

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Also, the Office maintains that although the disclosure states in part that the controller being programmed to choose indicia designed to attract a player to the slot machine such as gaming instructions such as to be preprogrammed to display an attract sequence or simulated game play as stated in paragraph 25, the specification does not reasonably convey to an artisan at the time of filing that inventors possessed the invention regarding dynamic [automatic/remote] reprogramming for changing the game play indicia on the gaming machine or to dynamically change the indicia. The Office maintains from prior action that dynamic reprogramming of indicia displayed is not supported by original specification to convey to an artisan at time of filing that inventor(s) possessed the invention to reprogram the indicia displayed on a game machine in so far as the language ‘changing the game play indicia on the gaming apparatus’ (claims 27, 32, 37, 44 and 77; Office notes inadvertent omission of claim 27 from group but language referred in prior action included language of claim 27), ‘themed’ (clms 41-43 and 76), ‘a theme’ (claim 57, 59 and 83) and ‘related to one or more of a particular casino, a gaming machine, a gaming area and a game show’ (claims 58, 60 and 84) continues to include to dynamically reprogram indicia to display such as to change theme to relate to a casino, gaming machine, gaming area or game show for its breadth. The specification (paragraph 25) does reasonably convey that inventors possessed changing indicia displayed on gaming machine such as to display attract sequence or simulation of game play where the instructions were pre-programmed, but the Office maintains from prior action that in so far as language to receive programming instructions for changing game play indicia on the gaming machine and to receive programming instructions to dynamically change the indicia continues to include dynamic reprogramming the indicia displayed, the written description does not reasonably convey

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inventors possessed the invention at time of filing. The Office previously acknowledged programming of computer as a gaming device was known to exist prior to instant application; however, the Office reiterates that Applicant is reminded of their duty to disclose their invention at time of filing so as to place the public in possession of what they invented. To be clear, the claim language 'changing the game play indicia' and 'dynamically change the indicia' continues to include reprogramming the indicia for its breadth and thus continues to fail to reasonably convey that inventors possessed the invention. Essentially, the disclosed form of invention including cited paragraphs in remarks on pages 15-16 is a gaming machine with instructions to display indicia for attract sequences and simulation of game play and the Office agrees that a gaming machine can have a predefined theme that can relate to a particular casino, game machine, gaming area or a game show; however, the originally filed specification does not reasonably convey to an artisan at time of filing that inventors possessed the invention regarding 'changing the game play indicia' and 'dynamically change the indicia' where such function also pertains to reprogram the indicia or change theme of gaming apparatus since there is no specific teaching for changing the indicia displayed including theme by dynamic reprogramming. Also, similarly, the language regarding 'a theme', 'themed' and 'related to one or more of a particular casino, a gaming machine, a gaming area and a game show' is supported in paragraph 26 only in so far as such is pre-defined or pre-programmed; however, the original specification does not convey to an artisan at time of filing that Applicant possessed the invention regarding changing indicia to alter the theme as claimed function since as reiterated from above, no reprogramming is taught to provide such function. Agreeably paragraph 26 discusses theme but there is not teaching that theme is dynamically changed as claimed. No factual evidence has been submitted

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that demonstrates originally filed disclosure taught/supports reprogramming the indicia and prior discussion in paragraph 23 is insufficient to demonstrate such reprogramming as stated in prior holding.

Applicant is required to cancel the new matter in reply to this Office Action.

3. Claims 27-60 and 63-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel rebuttal is provided below and incorporated herein.

4. Claims 27-60 and 63-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel remark is provided below and incorporated herein.

5. Claims 27-60 and 63-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel assertions is provided below and incorporated herein.

The cited claims are indefinite since it is unclear how an virtually unlimited number of indicia (such as the number approaching infinity as alleged in remarks) are displayed or how

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indicium are selected/determined from an infinite number of indicia or how the gaming apparatus stores an infinite number of indicium for selection/determination at least since the display, memory and controller are each finite in capability, but the claimed indicia/indicium pertains to an infinite number of indicia and infinite is indefinite.

### ***Response to Arguments***

6. Applicant's arguments filed Nov 5, 2009 have been fully considered but they are not persuasive. At outset, the Office notes objection above that cited amendment enters new matter for 'virtually unlimited' if 'virtually unlimited' has a different meaning than infinite since there is no basis in record for change from infinite to virtually unlimited. By analogy only, this change is similar to changing from 12 inches to 11 but with no factual evidence in record to support; whereas changing 12 inches to 'a foot' is permissible, but regarding the aforementioned change from 12 to 11 there needs to be factual evidence in record to warrant the change that even though by current argument, 11 approaches 12, by what factual basis is virtually unlimited supported?

The remark on page 14 alleges no new matter was added and states a definition for 'infinite'. The Office does not agree with stated definition for reasons that will be clear due to inconsistency noted next.

The arguments on pages 14-15 provides a non-limiting example based on a calculation of a hypothetical array of pixels; but then the arguments states 'for all practical purposes it approaches infinity'. Thus, it appears the argument is that the invention is 'one less [or some other undefined value less] than infinite' for it approaches infinity and thus the Office disagrees with proffered definition and maintains the disclosed invention pertains to displaying an infinite number of symbols which is indefinite, undefined and unachievable as stated in prior holding. In

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consideration of Counsel/Applicant argument that 'it approaches infinity' so as to be some undefined value less than infinite then the disclosed form remains displaying essentially an infinite number of indicia at least since some undefined value less than infinite remains infinite and where 'virtually unlimited' as would be apparent to an artisan has no discernible difference from infinite since there is no evidence in record that defines such difference so as to put public in possession of invention at time of filing. The Office further notes remark on bottom page 15 states in part 'programmed to determine an infinite variety of game play indicia'; thus, argument that 'virtually unlimited' has a different meaning than infinite is inconsistent if a difference is implied such as virtually unlimited being a subset of infinite since infinite is an undefined value and to allege virtually unlimited as being definitive and supported where the invention including 'virtually unlimited' approaches infinity is not persuasive and continues to fail to put public in possession of scope of invention and fails to reasonably convey that inventors possessed the invention as maintained from prior action as reiterated in evidence below. Analogy above is incorporated herein in so far as what basis is 'virtually unlimited' supported and defined so as to put public in possession of invention at time of filing.

In reply to remark on page 15 that replacing 'addressable pixels' with a panel having a plurality of portions each portion configured to display indicia', the Office disagrees in so far as portions appears to continue to pertain to addressable pixels and thus fails to overcome holding.

The allegations on pages 15-16 for claims 27-60 and 63-86 regarding 'changing the game play indicia' and to 'dynamically change the indicia' state the function is supported by paragraphs 25-26, the Office disagrees and maintains that broadest reasonable interpretation of the form of invention also includes reprogramming indicia that the written description does not



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reasonably convey to an artisan that inventor possessed the invention as stated in evidence above in that although one form is supported (i.e. preprogrammed), the breadth of language includes a form not supported (i.e. reprogramming). Further, regarding request for reconsideration of claims 41-43, 76, 58, 60 and 84 as being supported at paragraph 26, the Office disagrees and maintains that the broadest reasonable interpretation of the claimed form also includes reprogramming indicia to change theme, related to one or more of the stated areas that the written description does not reasonably convey to an artisan at time of filing that inventor possessed the invention where although one form (i.e. preprogrammed) is supported, the breadth of claim language includes reprogramming that is not supported. Possibly consider adding 'preprogrammed' (or similar) to preclude form regarding reprogramming. It is also noted on bottom of page 15 that Applicant/Counsel allege the controller is programmed to determine an infinite variety of game play indicia.

In response to assertions regarding enablement of claims 27-60 and 63-86 on page 16 that inventor definition for infinite is 'virtually unlimited', the Office notes that although an artisan may be their own lexicographer, in this case, there is no evidence in the record that demonstrates that inventor provided such definition with reasonable clarity, deliberateness, and precision" and, if done, must "set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). Also, timeliness of such definition stated in present amendment is questionable as to whether the public was put in possession of such definition at time of filing. Also, there is no evidence in record that 'virtually unlimited' is consistent with dictionary definition of infinite provided on

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pages 14 and 16 from Webster's especially in light that remarks page 15 as noted above states that 'for all practical purposes it approaches infinity' and thus, the Office notes is evidence that to the contrary the use of 'infinite' and its replacement 'virtually unlimited' refers to the more mathematical definition stated on bottom of page 16. Thus, the Office maintains prior holding that invention is not enabled since with due consideration of assertions and evidence proffered, the original specification requires as would be interpreted by an artisan regarding [paraphrased] 'displaying the indicia', 'determine indicia to display', 'dynamically change the indicia displayed' to pertain to displaying an infinite number of indicia [or some number less than infinite], determining indicia to display from an infinite [or some undefined number less than infinite] number of indicia and dynamically change the indicia displayed from an infinite number of indicia [or some undefined number less than infinite]; however, since display, memory and processing is finite the invention is inept to perform such infinite function.

In reply to remark on page 17 that replacement of infinite with virtually unlimited places the specification and claims in compliance with written description, the Office disagrees for reasons stated above incorporated herein in that Applicant failed to exercise right to be their own lexicographer, there is no evidence for reason to enter 'virtually unlimited' to replace infinite [note analogy above], the scope of 'virtually unlimited' appears most consistent with the mathematical definition on bottom page 16 at least due to remark on page 15 'that for all practical purposes it approaches infinity' and persistent remarks by Applicant throughout prosecution for reference to displaying an infinite variety of symbols and thus infinite and virtually unlimited is indistinguishable from meaning without limit, unbounded, boundless, etc.

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Further, regarding indefiniteness of claims 27-60 and 63-86, the Office disagrees for reasons stated above incorporated herein in that Applicant failed to exercise right to be their own lexicographer, there is no evidence for reason to enter 'virtually unlimited' to replace infinite [note analogy above], the scope of 'virtually unlimited' appears most consistent with the mathematical definition on bottom page 16 at least due to remark on page 15 'that for all practical purposes it approaches infinity' and persistent remarks by Applicant throughout prosecution for reference to displaying an infinite variety of symbols and thus infinite and virtually unlimited is indistinguishable from meaning without limit, unbounded, boundless, etc.

Also, the Office has not applied art due to no known processor, memory or display can process to select/determine, display or store an infinite number of indicia. However, relevant art believe to be of record pertains to Loose 6517433, Inoue 5752881, Hagiwara 4838552 and Yamamoto 5135224 for endless belt with consideration of Joshi 6939226 for reprogramming symbols and articles Universal Display: FOLED and Business Week 2000: The Tube for particular thin film, but not applied herein for aforementioned infinite number of symbols issue.

### ***Conclusion***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/  
Primary Examiner, Art Unit 3714